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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,172	11/14/2003	Aaron Partridge	11403/84	9823
26646 7590 02/26/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
SMITH, FRANCIS P				
ART UNIT		PAPER NUMBER		
1792				
MAIL DATE		DELIVERY MODE		
02/26/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/713,172

Applicant(s)

PARTRIDGE ET AL.

Examiner

Francis P. Smith

Art Unit

1792

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 February 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-30 and 41-56

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____

/Michael Kornakov/
Supervisory Patent Examiner, Art Unit 1792

/Francis Smith/
Examiner

Continuation of 3. NOTE: Amendment to claims 1 and 41, if entered, changes the scope of the dependent claims, which would require at least additional consideration and possibly a new search.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants argue the prior art reference to Yu does not "disclose or suggest forming a silicon dioxide layer which includes heating a substrate to anneal a sub-layer of the silicon oxide layer, where the temperature to which the substrate is heated for the annealing is approximate to a highest processing temperature applied subsequent to the forming of the silicon oxide layer". The examiner respectfully disagrees. In examples 1-5, Yu clearly teaches forming a silicon oxide layer at a first temperature (e.g. 920 C). Subsequently, Yu's examples 6-8 teach applying a post anneal step "having formed thereupon the gap filling silicon oxide layer" (col. 10, lines 56-66). Furthermore, it has been held that the selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results. It is also noted that the secondary reference to Ito at least teaches forming a silicon oxide layer (e.g. at a first temperature), heating the substrate to a second temperature wherein the second temperature is approximate to the highest processing temperature subsequently applied to the substrate following the formation of the silicon oxide layer, and whereby the film is formed by an iterative process (see Ito; col. 3, line 64-col. 4, line 4, 49-65). Applicants also argue that the Yu/Ito combination does not disclose nor suggest forming a silicon oxide layer with a compressive stress. However, it is noted that Yu/Ito teach substantially the same process steps as those recited in claim 11. As per Applicants' argument that Yu/Ito does not disclose or suggest "forming a silicon oxide layer with a compressive stress," it is axiomatic that one who performs the steps of a process must necessarily produce all of its advantages and the mere recitation of a newly discovered property that is inherently possessed by the steps in the prior art does not cause a claim drawn to those steps to distinguish over the prior art. Furthermore, independent claims 1 and 41 are currently amended, which changes the scope of at least the dependent claims; and there, additional considerations are deemed necessary.